

**To:** Miarko, Inc. (DSteele@Hemmerlaw.com)  
**Subject:** TRADEMARK APPLICATION NO. 78516920 - FLEABAY - N/A  
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**UNITED STATES PATENT AND TRADEMARK OFFICE**

**SERIAL NO:** 78/516920

**APPLICANT:** Miarko, Inc.

**\*78516920\***

**CORRESPONDENT ADDRESS:**

DAVID H. STEELE  
HEMMER PANGBURN DEFRANK PLLC  
SUITE 200  
250 GRANDVIEW DRIVE  
FORT MITCHELL, KY 41017

**RETURN ADDRESS:**

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

**MARK:** FLEABAY

**CORRESPONDENT'S REFERENCE/DOCKET NO:** N/A

**CORRESPONDENT EMAIL ADDRESS:**

DSteele@Hemmerlaw.com

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

## OFFICE ACTION

**RESPONSE TIME LIMIT:** TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE MAILING OR E-MAILING DATE.

Serial Number 78/516920

The assigned examining attorney has reviewed the referenced application and determined the following:

### LIKELIHOOD OF CONFUSION – SECTION 2(d)

The examining attorney refuses registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), because the applicant's mark, when used on or in connection with the identified goods or services, so resembles the marks in U.S. Registration Nos. 2218732, 2420512, 2218732, 2514362, 2555505 and 2913227 (all owned by the same registrant) as to be likely to cause confusion, to cause mistake, or to deceive. TMEP section 1207. See the attached registrations.

The examining attorney must analyze each case in two steps to determine whether there is a likelihood of confusion. First, the examining attorney must look at the marks themselves for similarities in appearance, sound, connotation and commercial impression. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Second, the examining attorney must compare the goods or services to determine if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely. *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Products Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978).

In this case, the applicant's mark is "FLEABAY" in standard character format for "flea markets."

The marks in the above-cited registrations are all variations of the mark "eBay." They are as follows, respectively:

1. "EBAY" in typed format for "on-line trading services in which seller posts items to be auctioned and bidding is done electronically, and providing evaluative feedback and ratings of sellers' goods and services, the value and prices of sellers' goods, buyers' and sellers' performance, delivery, and overall trading experience in connection therewith"
2. "EBAY" in stylized lettering for "On-line trading services to facilitate the sale of goods by others via a computer network and providing evaluative feedback and ratings of sellers' goods and services, the value and prices of sellers' goods, buyers' and sellers' performance, delivery, and overall trading experience in connection therewith"
3. "EBAY" in stylized lettering with the colors red, blue, yellow, green, purple, orange and brown (the last letter "y" being in green, like the applicant's proposed mark) for "On-line trading services to facilitate the sale of goods by others via a computer network and providing evaluative feedback and ratings of sellers' goods and services, the value and prices of sellers' goods, buyers' and sellers' performance, delivery, and overall trading experience in connection therewith"

4. "EBAY POWER SELLERS" with a circular design for "Providing customer support services concerning online account management and use of online services; and Providing dedicated technical assistance"
5. "EBAY PREMIER" in typed format for "on-line trading services in which seller posts items to be sold at a set price, or alternatively to be offered in an auction-style format where bidding is done electronically, and providing evaluative feedback and ratings of sellers' goods and services, the value and prices of sellers' goods, buyers' and sellers' performance, delivery and overall trading experience in connection therewith"
6. "EBAY LIVE!" in standard character format for "arranging and conducting trade shows and exhibitions in the field of online trading services."

The applicant's proposed mark "FLEABAY" is confusingly similar to all of these registered marks because it is very similar to them in sound, appearance and meaning. First, the dominant portion of the marks, "BAY," is identical. The marks are compared in their entireties under a Section 2(d) analysis. Nevertheless, one feature of a mark may be recognized as more significant in creating a commercial impression. Greater weight is given to that dominant feature in determining whether there is a likelihood of confusion. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (C.C.P.A. 1976). *In re J.M. Originals Inc.*, 6 USPQ2d 1393 (TTAB 1987); TMEP §1207.01(b)(viii).

In this case, the term "flea" in applicant's mark is clearly descriptive because the applicant's services – as shown by the identification of services – are flea markets. In the registered marks, the prefix "e" is descriptive in that it has become commonly recognized as a designation for goods or services that are electronic in nature or are sold or provided electronically. Please see the attached dictionary definition from *Encarta World English Dictionary*, online edition, which is attached to this office action. The additional wording in the registrant's other marks are all descriptive or weak so that "BAY" is the consistent dominant feature of registrant's marks. For these reasons, the term "BAY" is clearly the dominant portion of applicant's mark and the cited registered marks.

In addition to sharing the identical dominant element, the marks also share a very similar appearance. The fact that applicant's mark is in standard characters while some of the cited registrant's marks are not does not obviate this refusal. To the contrary, it supports it. Registration of a mark in typed or standard character form means that the mark may be displayed in any lettering style. 37 C.F.R. §2.52(a). The rights associated with a mark in typed or standard character form reside in the wording itself, and applicant is free to adopt any style of lettering, including lettering identical to that used by the registrant. Therefore, presentation of a mark in special form will not avoid likelihood of confusion with a mark that is registered in typed or standard character form because the marks presumably could be used in the same manner of display. *See In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); *In re Pollio Dairy Prods. Corp.*, 8 USPQ2d 2012 (TTAB 1988); *Sunnen Prods. Co. v. Sunex Int'l Inc.*, 1 USPQ2d 1744, 1747 (TTAB 1987); *In re Hester Indus., Inc.*, 231 USPQ 881, 882, n.6 (TTAB 1986); *United Rum Merchants, Ltd. V. Fregal, Inc.*, 216 USPQ 217 (TTAB 1982); *Frances Denney, Inc. v. Vive Parfums, Ltd.*, 190 USPQ 302 (TTAB 1976); *See also* TMEP §1207.01(c)(iii).

For all of these reasons, the marks create a very similar commercial impression.

The services here are closely related because they overlap, are marketed in the same trade channels and it is quite conceivable for the registrant to expand into flea market services, which are the applicant's services. Any goods or services in the registrant's normal fields of expansion must also be considered in order to determine whether the registrant's goods or services are related to the applicant's identified goods or services for purposes of analysis under Section 2(d). *In re General Motors Corp.*, 196 USPQ 574 (TTAB 1977). The test is whether purchasers would believe the product or service

is within the registrant's logical zone of expansion. *CPG Prods. Corp. v. Perceptual Play, Inc.*, 221 USPQ 88 (TTAB 1983); TMEP §1207.01(a)(v). As flea markets could be easily conducted online, like other online retail and wholesale services, the average consumer would likely believe that these services are within the registrant's logical zone of expansion.

Taken together, the close similarity of the marks and the close relationship of the services necessitate that registration for the proposed mark be refused. Although the trademark examining attorney has refused registration, applicant may respond to the refusal to register by submitting evidence and arguments in support of registration. If applicant chooses to respond to the refusal(s) to register, then applicant must also respond to the following requirement.

Please note that there is no required format or form for responding to this Office action. However, applicant should include the following information on all correspondence with the Office: (1) the name and law office number of the examining attorney; (2) the serial number of this application; (3) the mailing date of this Office action; and, (4) applicant's telephone number.

When responding to this Office action, applicant must make sure to respond in writing to each refusal and requirement raised. If there is a refusal to register the proposed mark, then applicant may wish to argue against the refusal, i.e., explain why it should be withdrawn and why the mark should register. If there are other requirements, then applicant should simply set forth in writing the required changes or statements and request that the Office enter them into the application record. Applicant must also sign and date its response.

/Susan Stiglitz/

Trademark Examining Attorney

USPTO

Law Office 103

(571) 272-9285

#### **HOW TO RESPOND TO THIS OFFICE ACTION:**

- **ONLINE RESPONSE:** You may respond formally using the Office's Trademark Electronic Application System (TEAS) Response to Office Action form (visit <http://www.uspto.gov/teas/index.html>) and follow the instructions, but if the Office Action has been issued via email, you must wait 72 hours after receipt of the

- Office Action to respond via TEAS).
- **REGULAR MAIL RESPONSE:** To respond by regular mail, your response should be sent to the mailing return address above and include the serial number, law office number and examining attorney's name in your response.

**STATUS OF APPLICATION:** To check the status of your application, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov>.

**VIEW APPLICATION DOCUMENTS ONLINE:** Documents in the electronic file for pending applications can be viewed and downloaded online at <http://portal.uspto.gov/external/portal/tow>.

**GENERAL TRADEMARK INFORMATION:** For general information about trademarks, please visit the Office's website at <http://www.uspto.gov/main/trademarks.htm>

**FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY SPECIFIED ABOVE.**

**Print: Jun 21, 2005**

**75391661**

**TYPED DRAWING**

**Serial Number**

75391661

**Status**

REGISTERED

**Word Mark**

EBAY

**Standard Character Mark**

No

**Registration Number**

2218732

**Date Registered**

1999/01/19

**Type of Mark**

SERVICE MARK

**Register**

PRINCIPAL

**Mark Drawing Code**

(1) TYPED DRAWING

**Owner**

eBay Inc. CORPORATION CALIFORNIA 2005 Hamilton Avenue, Suite 350 San Jose CALIFORNIA 95125

**Goods/Services**

Class Status -- ACTIVE. IC 035. US 100 101 102. G & S: on-line trading services in which seller posts items to be auctioned and bidding is done electronically, and providing evaluative feedback and ratings of sellers' goods and services, the value and prices of sellers' goods, buyers' and sellers' performance, delivery, and overall trading experience in connection therewith. First Use: 1995/09/04. First Use In Commerce: 1995/09/04.

**Filing Date**

1997/11/17

**Examining Attorney**

UNKNOWN

**Attorney of Record**

LARISSA A.J. KEHOE

**Print: Jun 21, 2005**

**75587191**

**DESIGN MARK**

**Serial Number**

75587191

**Status**

REGISTERED

**Word Mark**

EBAY

**Standard Character Mark**

No

**Registration Number**

2420512

**Date Registered**

2001/01/16

**Type of Mark**

SERVICE MARK

**Register**

PRINCIPAL

**Mark Drawing Code**

(3) DESIGN PLUS WORDS, LETTERS AND/OR NUMBERS

**Owner**

eBay, Inc. CORPORATION DELAWARE 2125 Hamilton Avenue San Jose  
CALIFORNIA 95125

**Goods/Services**

Class Status -- ACTIVE. IC 035. US 100 101 102. G & S: On-line trading services to facilitate the sale of goods by others via a computer network and providing evaluative feedback and ratings of sellers' goods and services, the value and prices of sellers' goods, buyers' and sellers' performance, delivery, and overall trading experience in connection therewith. First Use: 1998/01/15. First Use In Commerce: 1998/01/15.

**Prior Registration(s)**

2218732

**Filing Date**

1998/11/12

**Examining Attorney**

MERCALDI, ANTHONY

**Print: Jun 21, 2005**

**75587191**

**Attorney of Record**

Larissa A J Kehoe



eBay

**Print: Jun 21, 2005**

**75669553**

**DESIGN MARK**

**Serial Number**

75669553

**Status**

REGISTERED

**Word Mark**

EBAY

**Standard Character Mark**

No

**Registration Number**

2410023

**Date Registered**

2000/12/05

**Type of Mark**

SERVICE MARK

**Register**

PRINCIPAL

**Mark Drawing Code**

(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM

**Owner**

eBay Inc. CORPORATION DELAWARE 2125 Hamilton Avenue San Jose  
CALIFORNIA 95125

**Goods/Services**

Class Status -- ACTIVE. IC 035. US 100 101 102. G & S: On-line trading services to facilitate the sale of goods by others via a computer network and providing evaluative feedback and ratings of sellers' goods and services, the value and prices of sellers' goods, buyers' and sellers' performance, delivery, and overall trading experience in connection therewith. First Use: 1998/01/15. First Use In Commerce: 1998/01/15.

**Prior Registration(s)**

2218732

**Lining/Stippling Statement**

The mark is lined for red, blue, yellow, green, purple, orange and brown.

**Filing Date**

1999/03/29

**Print: Jun 21, 2005**

**75669553**

**Examining Attorney**

MERCALDI, ANTHONY

**Attorney of Record**

LARISSA A.J. KEHOE

copy

**Print: Jun 21, 2005**

**76002885**

**DESIGN MARK**

**Serial Number**

76002885

**Status**

REGISTERED

**Word Mark**

EBAY POWER SELLERS

**Standard Character Mark**

No

**Registration Number**

2514362

**Date Registered**

2001/12/04

**Type of Mark**

SERVICE MARK

**Register**

PRINCIPAL

**Mark Drawing Code**

(3) DESIGN PLUS WORDS, LETTERS AND/OR NUMBERS

**Owner**

eBay Inc. CORPORATION DELAWARE 2145 Hamilton Avenue San Jose  
CALIFORNIA 95125

**Goods/Services**

Class Status -- ACTIVE. IC 035. US 100 101 102. G & S: Providing customer support services concerning online account management and use of online services. First Use: 1999/06/00. First Use In Commerce: 1999/06/00.

**Goods/Services**

Class Status -- ACTIVE. IC 042. US 100 101. G & S: Providing dedicated technical assistance. First Use: 1999/06/00. First Use In Commerce: 1999/06/00.

**Filing Date**

2000/03/17

**Examining Attorney**

KOVALSKY, LAURA

**Attorney of Record**

**Print: Jun 21, 2005**

**76002885**

Larissa A.J. Kehoe



**Print: Jun 21, 2005**

**76184915**

**DESIGN MARK**

**Serial Number**

76184915

**Status**

REGISTERED

**Word Mark**

EBAY PREMIER

**Standard Character Mark**

No

**Registration Number**

2555505

**Date Registered**

2002/04/02

**Type of Mark**

SERVICE MARK

**Register**

PRINCIPAL

**Mark Drawing Code**

(3) DESIGN PLUS WORDS, LETTERS AND/OR NUMBERS

**Owner**

eBay Inc. CORPORATION DELAWARE 2145 Hamilton Avenue San Jose  
CALIFORNIA 95125

**Goods/Services**

Class Status -- ACTIVE. IC 035. US 100 101 102. G & S: on-line trading services in which seller posts items to be sold at a set price, or alternatively to be offered in an auction-style format where bidding is done electronically, and providing evaluative feedback and ratings of sellers' goods and services, the value and prices of sellers' goods, buyers' and sellers' performance, delivery and overall trading experience in connection therewith. First Use: 2001/01/04. First Use In Commerce: 2001/01/04.

**Prior Registration(s)**

2218732;2410023;2420512

**Description of Mark**

The mark features the following color "e" in red, overlapping "e" and "b" section in purple, "b" in blue, overlapping "b" and "a" section in orange, "a" in yellow, overlapping "a" and "y" section in brown, "y" in green, and two color dashes above the "i" in yellow and light blue.



**Print: Jun 21, 2005**

**76184915**

**Filing Date**

2000/12/21

**Examining Attorney**

KHAN, ASMAT

**Attorney of Record**

Larissa Kehoe Hoffman

eBay Premier

**Print: Jun 21, 2005**

**78339332**

**DESIGN MARK**

**Serial Number**

78339332

**Status**

REGISTERED

**Word Mark**

EBAY LIVE!

**Standard Character Mark**

Yes

**Registration Number**

2913227

**Date Registered**

2004/12/21

**Type of Mark**

SERVICE MARK

**Register**

PRINCIPAL

**Mark Drawing Code**

(4) STANDARD CHARACTER MARK

**Owner**

eBay Inc. CORPORATION DELAWARE 2145 Hamilton Avenue San Jose  
CALIFORNIA 95125

**Goods/Services**

Class Status -- ACTIVE. IC 035. US 100 101 102. G & S: arranging  
and conducting trade shows and exhibitions in the field of online  
trading services. First Use: 2002/06/01. First Use In Commerce:  
2002/06/01.

**Filing Date**

2003/12/11

**Examining Attorney**

GRAY, CAROLYN

**Attorney of Record**

Francine M. Hanson

**EBAY LIVE!**

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## Dictionary

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**e-**

**e-**

**prefix**

1. electronic
  - *e-mail*
2. electronic data transfer via the Internet
  - *e-commerce*

[Abbreviation of electronic]

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